

## REMARKS

The Examiner indicated that the drawings filed on 7/27/1999 are not approved by the draftperson under 37 CFR 1.84 or 1.152, and that formal drawings are required. Formal drawings are included with this office action as requested.

The Examiner indicated that certain IDS items riled on January 21, 2000 are not received. The IDS items are not available to be sent with this office action; however, these items have been requested and will be submitted once they have been received.

Claim 35 has been withdrawn. Claims 1, 3, 4, 15, 18, 20, 21, 23, 26, 27, 30, 33, and 34. have been amended to clarify the subject matter regarded as the invention. Claims 2, 19, and 22 are cancelled. Claims 1, 2-18, 20, 21, and 23-34 are pending.

The Examiner has indicated that claims 18, 30, and 33-34 are rejected under 35 USC 101. Claims 18, 30, and 33-34 produce a recommendation package, recommended information, a recommendation package, or recommended documents, respectively, which are useful, concrete, and tangible results and are not directed to a law of nature, physical phenomena, or abstract ideas. Also, in *Ex Parte Lundgren*, 76 USPQ2d 1385 (BdPatApp&Int 2005), it was found that there is no judicially recognized separate “technological arts” test for determining whether claimed process or method constitutes patentable subject matter under 35 USC 101 and that an application claiming a method of compensating manager of business firm was improperly rejected for claiming non-statutory subject matter, even though invention is not limited to “technological arts,” since claimed method produces useful, concrete, and tangible result, and claims are not directed to law of nature, physical phenomena, or abstract ideas. It is therefore believed that claims 18, 30, and 33-34 are allowable. Claims 20, 21, 23-26 and 31, 32 depend from claims 18 and 30, respectively, and are therefore believed to be allowable as well.

The Examiner has rejected claim 1 under 35 USC 102 as being anticipated by Zellweger and Jacobi et. al. The rejection is respectfully traversed. Zellweger teaches “methods and apparatus of a menu management system that serves as a marketing research tool that can generate end-user profiles and report on these profiles over time.” Zellweger does not teach “determining based on the user profile, using the at least one recommendation software application, the interests of the user, and providing the user with recommended information by email, using the at least one recommendation software application, based upon the determined interests of the user” as amended Claim 1 recites. Jacobi teaches recommending “products or

other items to a user based on a set of items known to be of interest to a user, such as a set of items currently in the user's shopping cart" where recommendations are "preferably determined by an off-line process that analyzes user purchase histories to identify correlations between purchases." Jacobi does not teach "creating a database entry for each user of a client document server using a tracking module; tracking requests by the user for at least one document on a client document server using the tracking module" or "providing the user with recommended information by email." It is therefore believed that claim 1, as amended, is allowable. Also, claims 3-14 depend from claim 1 and are therefore also believed to be allowable.

The Examiner has rejected claim 15 under 35 USC 102 as being anticipated by Jacobi et. al. The rejection is respectfully traversed. Jacobi teaches that recommendations "are preferably presented to the user on the same Web page (not shown) as the shopping cart contents." Jacobi does not teach "receiving , on the computer, by email a list of links to at least one document recommended by the at least one recommendation software application responsive to the transmitted content information" as amended claim 15 recites. Therefore, it is believed that claim 15 is allowable. Also, claims 16 and 17 depend from 15 and so are believed to be allowable as well.

The Examiner has rejected claim 18 under 35 USC 102 as being anticipated by Jacobi et. al. The rejection is respectfully traversed. Jacobi teaches recommending "products or other items to a user based on a set of items known to be of interest to a user, such as a set of items currently in the user's shopping cart" where recommendations are "preferably determined by an off-line process that analyzes user purchase histories to identify correlations between purchases." Jacobi does not teach generating "a personalized recommendation package for the user, wherein the personalized recommendation package for the user is accessed by the user using an email" as amended claim 18 recites. It is therefore believed that claim 18 is allowable. Claims 20, 21, and 23-26 depend from claim 18 and are therefore also believed to be allowable.

The Examiner has rejected claim 27 and 30 under 35 USC 102 as being anticipated by Jacobi et. al. The rejection is respectfully traversed. Jacobi teaches recommending "products or other items to a user based on a set of items known to be of interest to a user, such as a set of items currently in the user's shopping cart" where recommendations are "preferably determined by an off-line process that analyzes user purchase histories to identify correlations between purchases." Jacobi does not teach "providing the user with recommended information by email based upon the determined interests of the user" as amended claim 27 and 30 recite. It is

therefore believed that claim 27 and 30 are allowable. Claims 28, 29 and 31, 32 depend from claim 27 and 30, respectively, and are therefore also believed to be allowable.


The Examiner has rejected claim 33 under 35 USC 102 as being anticipated by Jacobi et al. The rejection is respectfully traversed. Jacobi teaches recommending “products or other items to a user based on a set of items known to be of interest to a user, such as a set of items currently in the user’s shopping cart” where recommendations are “preferably determined by an off-line process that analyzes user purchase histories to identify correlations between purchases.” Jacobi does not teach that “the recommendation system is operable to recommend documents to the user in response to the determined profile” and that “the recommendation system is operable to provide a personalized recommendation package to the user by email in response to the determined profile a personalized recommendation package for the user” as amended claim 33 recites. It is therefore believed that claim 33 is allowable.

The Examiner has rejected claim 34 under 35 USC 102 as being anticipated by Jacobi et al. The rejection is respectfully traversed. Jacobi teaches recommending “products or other items to a user based on a set of items known to be of interest to a user, such as a set of items currently in the user’s shopping cart” where recommendations are “preferably determined by an off-line process that analyzes user purchase histories to identify correlations between purchases.” Jacobi does not teach categorizing “at least second document, according to the theme or concept of the at least one interest folder” and recommending “to the user by email the at least second categorized document” as amended claim 34 recites. It is therefore believed that claim 34 is allowable.

Reconsideration of the application and allowance of all claims are respectfully requested based on the preceding remarks. If at any time the Examiner believes that an interview would be helpful, please contact the undersigned.

Respectfully submitted,

Dated: 16 December 2005

  
\_\_\_\_\_  
Terrence L. Wong  
Registration No. 55,741  
V 408-973-2585  
F 408-973-2595

VAN PELT, YI & JAMES LLP  
10050 N. Foothill Blvd., Suite 200  
Cupertino, CA 95014